

**THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB**

Mailed:  
May 19, 2004  
Bucher

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Thor Tech, Inc.

Serial No. 76251568

B. Joseph Schaeff of Dinsmore & Shohl LLP for Thor Tech,  
Inc.

Won T. Oh, Trademark Examining Attorney, Law Office 114  
(K. Margaret Le, Managing Attorney).

Before Hanak, Chapman and Bucher, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Thor Tech, Inc. seeks registration on the Principal  
Register of the mark TAXIVAN for goods identified in the  
application as filed as follows:

"vehicles modified for use by able-bodied,  
physically disabled or otherwise  
transportationally disadvantaged people,  
including a wheelchair lift and accessories  
for use therewith, and retrofit kits to  
modify vehicles to include a wheelchair lift

and accessories for use therewith," in International Class 12.<sup>1</sup>

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon the ground that this term is merely descriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and based upon the refusal that the amended identification of goods is unacceptable as indefinite.

Both applicant and the Trademark Examining Attorney have fully briefed the case. Applicant did not request an oral hearing before the Board.

We turn first to the refusal based upon the latest amendment to the identification of goods proffered by applicant but rejected as indefinite by the Trademark Examining Attorney.

As noted earlier, the original identification of goods, as filed, read as follows:

"vehicles modified for use by able-bodied, physically disabled or otherwise transportationally disadvantaged people, including a wheelchair lift and accessories for use therewith, and retrofit kits to modify vehicles to include a wheelchair lift and accessories for use therewith."

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<sup>1</sup> Application Serial No. 76251568 was filed on May 4, 2001 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

The Trademark Examining Attorney suggested the following identification, if accurate:

"motor vehicles, namely vans modified for use by able-bodied, physically disabled or otherwise transportationally disadvantaged people with a wheelchair lift; motor vehicle retrofit kits primarily composed of [indicate primary components of kits, e.g., wheelchair lifts, handrails] for modifying motor vehicles to attach a wheelchair lift."

In its request for reconsideration, applicant proposed the following amendment:

"motor vehicles modified for use by able-bodied, physically disabled or otherwise transportationally disadvantaged people, namely motor vehicles with wheelchair lifts, ramps and/or lowered floors, and motor vehicle retrofit conversion packages to modify motor vehicles with wheelchair lifts"

In denying applicant's request for reconsideration, the Trademark Examining Attorney explained his continuing refusal to register based upon the unacceptability of the latest amendment as follows:

[A]pplicant's amended identification of goods is also unacceptable because applicant has not specified the common commercial name of the motor vehicle. Applicant is advised that the term "motor vehicle" in its broadest sense may include an automobile, a motorcycle, and airplane and a motorized scooter. The wording "motor vehicle" is unacceptable as indefinite..."

Then in its appeal brief, applicant argued that it had amended its identification of goods to the following:

"motor vehicles modified for use by able-bodied, physically disabled or otherwise transportationally disadvantaged people, namely passenger vehicles with wheelchair lifts, ramps and/or lowered floors, and motor vehicle retrofit conversion packages to modify passenger vehicles with wheelchair lifts"

When the Trademark Examining Attorney objected to this statement as inaccurate, applicant submitted with its reply brief the copy of an amendment apparently submitted at the same time as it submitted its appeal brief, changing the words "motor vehicles" to "passenger vehicles" in two places within the identification of goods. The Trademark Examining Attorney had no opportunity to respond to this amendment (which original amendment was never associated with the case file). However, in his brief, he did note that the continuing requirement for an acceptable identification of goods was based on the earlier wording "motor vehicles."

We find, based upon a close review of this entire exchange, that the last identification of goods proffered by applicant should be sufficiently definite to be approved as acceptable.

As to the requirement for applicant to specify the type of vehicle ("namely vans"), we find that the balance of the latest identification of goods focuses on vehicles

having wheelchair lifts, ramps and/or lowered floors. This additional clarification logically suggests a large land vehicle such as a van or a bus. Motorcycles, motor scooters and most sedans, (e.g., the Trademark Examining Attorney's examples of what the designation "motor vehicles" might still include) would seem to be eliminated, by definition, from vehicles equipped with wheelchair lifts, ramps and/or lowered floors.

Second, as to the difference between "motor vehicles" and "passenger vehicles" (in the middle and towards the end of the identification of goods), it seems, again, impliedly true, that any "motor vehicle" modified to be accessible to handicapped people would be a "passenger vehicle."

And finally, while the original identification of goods language describing the conversion packages may well have contained some ambiguous formulations ("... retrofit kits to modify vehicles to *include* a wheelchair lift and *accessories for use therewith* ..."), the latest wording makes it clear that these are essentially conversion kits to install "wheelchair lifts" and requires no further clarification.

Accordingly, we find the language proffered by applicant at the time of its appeal brief to be acceptable:

"motor vehicles modified for use by able-bodied, physically disabled or otherwise transportationally disadvantaged people, namely passenger vehicles with wheelchair lifts, ramps and/or lowered floors, and motor vehicle retrofit conversion packages to modify passenger vehicles with wheelchair lifts."

Hence, we reverse this requirement and the attendant refusal to register until such requirement is met.

We turn then to the issue of descriptiveness. The Trademark Examining Attorney argues that the word "taxi" describes the intended use for applicant's motor vehicles and that the word "van" identifies the nature of the vehicle. On the other hand, applicant argues that when one applies our legal precedent to the evidence of record, this term is, at worst, suggestive, not merely descriptive.

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is intended to be used. A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods

or services. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The question of whether a particular term is merely descriptive is not decided in the abstract. Rather, the proper test in determining whether a term is merely descriptive is to consider the mark in relation to the goods for which registration is sought, the context in which the mark is used or is intended to be used, and the possible significance that the mark is likely to have on the average purchaser encountering the goods in the marketplace. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); and In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995).

Applicant argues throughout the prosecution of this application that the results of none of the four tests that shed light on the line between suggestiveness and descriptiveness support the conclusions drawn by the Trademark Examining Attorney.<sup>2</sup> Our principal reviewing Court (and its predecessor) have adopted similar tests for

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<sup>2</sup> Applicant cites and strongly relies on the case of Zatarians, Inc. v. Oak Grove Smokehouse, Inc. et al., 217 USPQ 988 (5<sup>th</sup> Cir. 1983) [FISH-FRI and CHICK-FRI found to be merely descriptive for coatings or batter mixes used to fry foods].

determining the distinction between descriptiveness and suggestiveness.<sup>3</sup> Hence, we have followed the structure of applicant's proposed analysis in looking at whether the evidence of record supports suggestiveness or mere descriptiveness when applied to the approaches of each of these four tests.

(i) The dictionary definition test

Applicant points out that the combined term, TAXIVAN, is not defined in any major dictionaries. In the absence of such entries, applicant argues, moreover, that the Trademark Examining Attorney has failed to show that the combined term has a well understood and recognized meaning.

However, the Trademark Examining Attorney did submit for the record several dictionary definitions, as follows:

**Taxi** - NOUN

A taxicab

- INTRANSITIVE VERB

1. To be transported by taxi

- TRANSITIVE VERB

1. To transport by or as if by taxi:

*taxied the children to dance class*

**Taxicab** - NOUN

An automobile that carries passengers for a fare, usually calculated by a taximeter

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<sup>3</sup> See Abcor, supra; Sperry Rand Corp. v. Sunbeam Corp., 442 F.2d 979, 170 USPQ 37 (CCPA 1971); DeWalt, Inc. v. Magna Power Tool Corp., 289 F.2d 656, 129 USPQ 275 (CCPA 1961); See also J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:66 - 11:69 (4<sup>th</sup> ed. June 2001).



**Van** - NOUN

1. a. An enclosed boxlike motor vehicle having rear or side doors and side panels especially for transporting people...

- TRANSITIVE VERB

to transport by van <sup>4</sup>

Applicant argues that taking the literal meanings of these words as defined by the Trademark Examining Attorney's own dictionary entries, one does not derive the Trademark Examining Attorney's suggested definition for the combined term, namely "vans that may be used to taxi people." Rather, applicant argues that consumers would need to use a degree of thought and imagination to arrive at this interpretation of the combined term. Applicant examines the word "taxi" as a verb and as a noun, and then combines it with the word "van," as a noun and as a verb, to illustrate the allegedly illogical results flowing from the literal definitions:

[The Trademark Examining Attorney's suggested] meaning does not flow logically from the definitions supplied. If the term TAXI in applicant's mark is viewed as a noun, then the term VAN must logically be viewed as a verb. The two-word phrase would therefore be rewritten as "a taxicab transports by van" a phrase whose meaning is murky at best. If, however, TAXI is treated as the verb and VAN as a noun, as suggested by the Examining Attorney's interpretation, we must decide whether TAXI is used in an

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<sup>4</sup> The American Heritage® Dictionary of the English Language (Third Edition 1992).

intransitive or transitive sense. As an intransitive verb, the noun VAN would serve in the place of the subject, notwithstanding its unusual placement after the verb. The phrase would thus be literally interpreted as "an enclosed motor vehicle being transported by a taxicab" .... Should TAXI be viewed as a transitive verb, VAN is most logically the object of the verb in light of its placement after the term TAXI. Hence, a literal reading gives us the meaning "to transport an enclosed vehicle by taxicab."

(Applicant's request for reconsideration, p. 7)

We do not find applicant's analysis to be persuasive. The dictionary entry for the word "taxi" placed into the record by the Trademark Examining Attorney traces the etymology of the two components of the term "taxicab." The roots of the word "taxi" refer to the measurement of a fare (e.g., the "taximeter"). The roots of the word "cab" suggest a form of public conveyance. As shown by the dictionary entry, in our modern, English-language usage, the noun form of the word "taxi" has become totally synonymous with the longer term, "taxicab." When the word "taxicab," is shortened to "taxi" in our everyday parlance, it retains the concept of a motor vehicle that carries passengers for a fare.

As a next step, we examine the body style of the involved motor vehicle. For the majority of people in the United States, the term taxicab conjures up images of a

four-door sedan. However, when the body style of a motor vehicle that carries people for a fare is that of a van or small bus, it seems entirely logical that this vehicle would be described as a "taxicab van." To the extent the words "cab" and "van" appear to be somewhat redundant in this context, one could anticipate that "taxicab van" would be shortened to just "taxi van" or "taxivan." Contrary to applicant's convoluted and rigid analysis of possible parts of speech of each of these components, in our declension of this combined term, the word "taxi" is still a noun, but used in this context as an adjective, describing the word "van."

(ii) The imagination test

Applicant argues that:

... as a result of the odd literal meanings of the combination of the terms TAXIVAN and the incongruity that results from the redundancy inherent in the mark, consumers are forced to rely on thought and imagination to derive a clear meaning from the text of the mark...

(Applicant's request for reconsideration of July 2003)

However, we do not find the instant case to be analogous to the facts in two cases cited by applicant, Airco, Inc. v. Air Products and Chemicals, Inc., 196 USPQ 832 (TTAB 1977) [AIR-CARE not merely descriptive of applicant's program of

scheduled maintenance of medical anesthesia and inhalation therapy equipment and hospital piping systems for medical gases] or In re John H. Breck, Inc., 150 USPQ 397 (TTAB 1966) [TINT TONE not merely descriptive of applicant's hair coloring preparation because placing the words "Tint" and "Tone" together is incongruous or redundant].

To the extent that the mark AIR-CARE creates an odd literal meaning ("care of the air") in the context of medical inhalation services, or even creates a play on the frequently used expression, "hair care," it certainly takes more cogitation, mental processing or gathering of further information in order for prospective customers of Air Products' services to readily perceive the descriptive significance of the term than is the case herein with the term TAXIVAN. Moreover, we find that the words "Taxi" and "Van," in the context of modified passenger vans, do not have the overlapping significance of the words "Tint" and "Tone" as applied to hair coloring preparations.

As indicated above in our discussion of the dictionary definitions of the individual components of TAXIVAN, when one views the common meaning of the word "taxi" as a noun used as an adjective modifying the word "van," it takes no

amount of mental processing to conclude that this is a boxlike vehicle that carries passengers for a fare.

(iii) Competitors' need test

In order to determine correctly the need of competitors to use the term, "taxi van," it is incumbent upon us to define clearly the field of competition. Judging by the identification of goods, we assume that applicant intends to sell passenger vehicles (e.g., passenger vans, small transit minibuses, shuttle buses, and the like) that have been modified to provide wheelchair accessible transit service to the disabled. The market for these paratransit vehicles would include public entities providing fixed commuter routes or demand responsive services, privately-operated shuttle systems and other transportation services (e.g., hotels, airport shuttles, etc.); and private entities primarily engaged in the business of transporting people (e.g., taxicab companies). However, irrespective of the form of ownership of a particular fleet of vehicles, when one's transportation is provided by a demand responsive service, it fits the intransitive verb form of the word "taxi" to conclude one is being "taxied," even if the service provider is not a traditional taxicab company. Granted, the case for

competitive need is certainly greatest whenever applicant's modified vans are sold to, and operated by, private taxi fleets. Such vehicles are clearly included in the identification of goods, and they will certainly be described as taxicab vans. Especially for competitors in this niche of the accessible van market, we find there is a competitive need to be able to use the term "taxi van" or "taxivan."

(iv) Competitors' use test

The Trademark Examining Attorney introduced into the record excerpted stories retrieved from the LEXIS/NEXIS database showing the term "Taxi van," as follows:

*HEADLINE:* "Cab for kids frees Mom and Dad..."  
At all times, Childrens Taxi vans carry two employees. One strictly navigates traffic while the driver's assistant walks each child to and from the van, opens the doors, provides security and talks with the children....  
The Tennessean, May 10, 2001.

*HEADLINE:* "Man faces 20 to 40 years for slashing cabby..."  
On the night of March 6, 2000, Lavender picked up Brown in her Friendly Taxi van on West Lemon Street, supposedly to take Brown to his job in Greenfield Industrial Park....  
Intelligencer Journal (Lancaster, PA), April 18, 2001.

However, applicant notes that in both of these cases, the word "Taxi" is part of the trade name of a taxicab company, and that although the words "Taxi" and "van" appear together, they do not provide any common understanding of the term "taxi van" (or "taxivan").

Moreover, we agree with applicant that the majority of the remaining stories in the record show usage of the term "taxi van" in other parts of the world, such as in Israel, Europe, Africa and the Caribbean. Although reported, for the most part, in newspapers in the United States, we find that these examples are not probative of a finding of mere descriptiveness of the term "taxi van" (or "taxivan") in the United States.

In its attempt to disprove mere descriptiveness, applicant refers to a recent attempt by Air Surrey Natural Gas Vehicles, Inc., to register the term TAXI VAN as a trademark in connection with "passenger vehicles, trucks, vans and campers." While this third-party, intent-to-use application was examined by another Trademark Examining Attorney and was published for opposition, we note that this application was subsequently withdrawn from publication and a non-final action was issued. Inasmuch as that application was later abandoned based upon Air Surrey's failure to

respond to the Office action, it has no probative value in support of applicant's position on descriptiveness herein.

As to actual usage by competitors of this term in a merely descriptive sense, we agree with applicant that the record contains not a single instance of such usage. On the other hand, the fact that applicant may be one of the first users of a term does not justify registration if the term is merely descriptive. See In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983). Hence, in light of our findings under the dictionary definition test, the imagination test and the competitive need test, *supra*, the fact that none of applicant's competitors has used this exact formulation does not demonstrate that the designation is not merely descriptive.

*Decision:* The identification of goods presented by applicant with its appeal brief is accepted and therefore the refusal to register based upon the requirement for an amended identification of goods is hereby reversed. On the other hand, the refusal to register based upon Section 2(e)(1) of the Trademark Act is hereby affirmed.